

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ERKKI KUISMA

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Appeal No. 97-3059  
Application 08/251,014<sup>1</sup>

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ON BRIEF

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Before KRASS, JERRY SMITH, and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed May 31, 1994. According to appellant, this application is a continuation-in-part of Application 07/887,079, filed May 22, 1992, now abandoned.

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Application No. 08/251,014

This is a decision on appeal from the final rejection of claims 1 through 7, 9 through 13 and 16 through 20, all of the claims pending in the application.

The invention is directed to a radio telephone comprising separate and distinct modules, each module is connected to a basic module for operation of the telephone in different modes.

Representative independent claim 1 is reproduced as follows:

1. A radio telephone for operating in at least two signal processing modes of operation, comprising:

a basic module (1) including basic circuitry consisting of all circuitry which is common to the operation of the telephone in both of the signal processing modes,

a discrete first supplementary module (2) including first supplementary circuitry consisting of only non-common circuitry for processing signals characteristic of a first one of the modes of operation, and

a discrete second supplementary module (3) including second supplementary circuitry consisting of only non-common circuitry for processing signals characteristic of a second one of the modes of operation,

wherein at least one of the first and second supplementary modules are detachably coupled to the basic module such that the telephone is operable in the first and second modes according to which of the first and second supplementary modules is coupled to the basic module.

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The examiner relies on the following references:

Mizikovsky	5,228,074	Jul. 13, 1993
	(filed Apr. 15, 1991)	

Tattari	5,265,158	Nov. 23, 1993
	(filed May 11, 1992)	

Claims 1 through 7, 9 through 13 and 16 through 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Mizikovsky in view of Tattari.

Reference is made to the brief and answer for the respective details of the positions of appellant and the examiner.

#### OPINION

We reverse.

The instant claimed invention requires a radio telephone which is operable in at least two modes. The telephone comprises a plurality of modules. There is a basic module which contains circuitry common to both modes of operation. Then there are at least two discrete supplementary modules. The first such supplementary module consists of non-common circuitry necessary for operation in the first mode and the second such supplementary module consists of non-common circuitry necessary for operation in the second mode. Each

supplementary module is connectable to the basic module in order to operate in either the first or the second mode. This describes independent claim 1.

Independent claim 11 allows for connecting both supplemental modules to the basic module together. Independent claim 16 describes the same invention as independent claim 1 but in a somewhat different manner, claiming "a primary supplemental module" to be connected to the basic module and that the primary supplemental module is selected from a group consisting of the first and second supplemental modules.

Independent claim 20 recites the basic module and only a first supplemental module detachably connected to the basic module. This claim, however, makes it clear that the basic module "is incapable of transmitting or receiving...unless the first supplemental module or a second alternative supplemental module is operably connected thereto."

In applying the art to claim 20, the examiner contends that Mizikovsky discloses everything but for the basic module being "incapable of transmitting or receiving..." The examiner then relies on Tattari for such a teaching and

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concludes that it would have been obvious to combine these teachings. We disagree.

The "basic module" (analog phone 1) in Mizikovsky is clearly capable of transmitting and receiving on its own whether or not it is connected to the digital unit 5 (although when so connected, it operates as a digital phone). Tattari discloses the construction of a radio telephone from a manufacturer's standpoint. While it is true that one unit of Tattari's phone will be incapable of transmitting and receiving until it is connected to another section, completing the construction of the phone, we find no relevance to the Mizikovsky device. Since the analog, or "basic," unit of Mizikovsky, is operative on its own, we fail to find any reason for the artisan to have been led, from any teachings of Tattari, to make unit 1 of Mizikovsky inoperable unless connected to another unit. The examiner's reasoning, i.e., "in order to have different modes of operation for the radio telephone" [bottom of page 3 of the answer], is not persuasive since Mizikovsky already discloses different modes of operation without having to leave unit 1 inoperable unless connected to another module. There would have been no reason,

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at least not for any articulated by the examiner, for the artisan to modify Mizikovsky in such a manner as to make unit 1 inoperable unless connected to another module.

Looking at the proposed combination from the point of view of Tattari, the radio telephone taught therein would not be a reconfigurable modular multiple system radio telephone. Once constructed, the radio telephone of Tattari is a complete, finished product. There would be no module interchange as in the instant claimed invention.

Moreover, each of the independent claims requires, in one way or another, that the basic module contain circuitry common to the operation of the telephone in both modes. Nothing in either of the applied references suggests this claimed limitation. Tattari is not directed to dual mode radio telephones but, rather, to the construction of a radio telephone. Once that telephone is constructed, it operates in whatever signal mode for which it was designed. In Mizikovsky, the "basic module," 1, has circuitry which permits complete operation by that unit alone. Not all of its circuitry is common to both modes of operation, as required by the instant claims. In response to this reasoning, the

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examiner argues [answer-page 7] that the language "all circuitry which is common..." is indefinite. We do not find the language indefinite. But, in any event, such a response would be a ground for rejection under 35 U.S.C. 112, second paragraph, a rejection which the examiner made earlier in the prosecution and withdrew. It is not a persuasive rationale for holding claimed subject matter obvious, within the meaning of 35 U.S.C. § 103.

In our view, the examiner has failed to establish a prima facie case of obviousness with regard to the instant claimed subject matter.

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Accordingly, the examiner's rejection of claims 1 through 7, 9 through 13 and 16 through 20 under 35 U.S.C. § 103 is reversed.

REVERSED

	Errol A. Krass	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Michael R. Fleming	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Jerry Smith	)	
	Administrative Patent Judge	)	

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